

REMARKS

Summary of the Office Action

The Abstract has been objected under M.P.E.P. § 608.01(b) as not showing the numerals in parentheses.

Claims 10, 11, and 13-16 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,273,199 to *Logtens*.

Claims 10-12, 14, 17, and 19 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,602,414 to *Garfinkel*.

Claims 10-11 and 13-19 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,568,579 to *Mochizuki*.

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Mochizuki*, in view of U.S. Patent No. 7,048,165 to *Haramiishi*.

Summary of the Response to the Office Action

Applicants cancel claims 13, without prejudice or disclaimer. Applicants amend claim 10 to include the subject matter of cancelled claim 13. No new matter has been introduced. Claims 22-27 are withdrawn from consideration. Accordingly, claims 10-12 and 14-21 are presently pending.

Objection to the Abstract

The Abstract was objected to for not putting numerals in parentheses. Applicants have amended the Abstract. Accordingly, Applicants respectfully request the objection to the Abstract be withdrawn.

All Claims Comply With 35 U.S.C. § 102

Claims 10, 11, and 13-16 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,273,199 to *Logtens*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Logtens* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 10 recites, in part, "an opening, formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is brought into contact with the roll staple," as amended. *Logtens* fails to teach or suggest at least these features of claim 10.

The Office Action equates the access opening (56) of *Logtens* located on a flat bottom surface with the claimed "an opening, formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is brought into contact with the roll staple." By contrast, *Logtens* does not disclose "an opening formed at a part of the staple case facing a circumferential surface of the roll staple," but rather the belt (14) in *Logtens* is brought into contact with the access opening (56) on the flat bottom surface of the cartridge (1). See Fig. 3 and col. 3, lines 44-56 of *Logtens*. Accordingly, *Logtens* fails to teach

or suggest each and every feature of claim 10. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Logtens* does not teach or suggest each feature of newly amended independent claim 10.

Additionally, Applicants respectfully submit that dependent claims 11, and 14-16 are also allowable insofar as they recite the patentable combinations of features recited in claim 10, as well as reciting additional features that further distinguish over the applied prior art.

Claims 10-12, 14, 17, and 19 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,602,414 to *Garfinkel*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Garfinkel* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 10 recites, in part, "an opening, formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is brought into contact with the roll staple," as amended. *Garfinkel* fails to teach or suggest at least these features of claim 10.

Garfinkel does not disclose "an opening formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is

brought into contact with the roll staple,” but rather a plurality of feed pawls (18) in *Garfinkel* pull the staples through a dispenser (11). See Figs. 4 and 5 and col. 2, lines 30-39 of *Garfinkel*. Accordingly, *Garfinkel* fails to teach or suggest each and every feature of claim 10. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Garfinkel* does not teach or suggest each feature of newly amended independent claim 10.

Additionally, Applicants respectfully submit that dependent claims 11-12, 14, 17, and 19 are also allowable insofar as they recite the patentable combinations of features recited in claim 10, as well as reciting additional features that further distinguish over the applied prior art.

Claims 10-11 and 13-19 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,568,579 to *Mochizuki*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Mochizuki* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(e) should be withdrawn. Newly amended independent claim 10 recites, in part, “an opening, formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is brought into contact with the roll staple,” as amended. *Mochizuki* fails to teach or suggest at least these features of claim 10.

The Office Action equates the opening (near roller 23) of *Mochizuki* which interfaces a flat bottom surface of “the plate-like roller guide” with the claimed “an opening, formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is brought into contact with the roll staple.” *Mochizuki* does not disclose “an opening formed at a part of the staple case facing a circumferential surface of the roll staple,” but rather the roller (23) in *Mochizuki* is brought into contact with a plate-like roller guide on the flat bottom surface of the cartridge (4). See Fig. 4 and col. 5, lines 27-35 of *Mochizuki*. Accordingly, *Mochizuki* fails to teach or suggest each and every feature of claim 10. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Mochizuki* does not teach or suggest each feature of newly amended independent claim 10.

Additionally, Applicants respectfully submit that dependent claims 11, and 13-19 are also allowable insofar as they recite the patentable combinations of features recited in claim 10, as well as reciting additional features that further distinguish over the applied prior art.

All Claims Comply With 35 U.S.C. § 103(a)

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Mochizuki*, in view of *Haramiishi*. Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see M.P.E.P. §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Mochizuki* and *Haramiishi*, whether alone or in combination, fail to teach or suggest all the recited features of independent claim 10. Newly amended independent claim 10 recites, in part, “an opening, formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is brought into contact with the roll staple.” *Mochizuki* or *Haramiishi*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 10.

As previously demonstrated, *Mochizuki* fails to teach or suggest each and every feature of claim 10. *Haramiishi* does not cure this deficiency in *Mochizuki*. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Mochizuki* or *Haramiishi*, whether taken alone or in combination, fails to teach or suggest fail to teach or suggest each feature of newly amended independent claim 10, the rejection under 35

U.S.C. § 103(a) should be withdrawn. Furthermore, claims 20-21 depend from independent claim 10. Accordingly, claims 20-21 are also allowable because of the additional features they recite and the reasons stated above.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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